

PATENT

Application # 10/664,754

Attorney Docket # 2002P15652US01 (1009-039)

## REMARKS

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The Examiner is respectfully thanked for the consideration provided to this application.

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

The specification and drawings have been amended to correct matters of form and one or more typographical errors. It is respectfully submitted that no new matter has been introduced.

Each of claims 1, 10, 11, 19, and 20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 are in independent form.

#### I. The Objection to the Drawings

The drawings were objected to under 37 C.F.R. 1.83(a) as allegedly failing to show "structural detail that is essential for a proper understanding of the disclosed invention".

Applicant respectfully traverses this objection.

37 C.F.R. 1.83(a) states:

[t]he drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled

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rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

Applicant respectfully submits that the present Office Action presents no evidence that the elements alleged as not shown in "structural detail" are "essential for a proper understanding of the disclosed invention". Applicant respectfully submits that the drawings as originally submitted shows "every feature of the invention specified in the claims" and that "conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention" are "illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation".

Accordingly, Applicant respectfully submits that the drawings as originally submitted comply with 37 C.F.R. 1.83(a). For at least these reasons, Applicant respectfully requests a withdrawal of the objections to the drawings.

## **II. The Objection to the Abstract**

The present Office Action objected to the Abstract "because the first few words comprise an implied phrase, '[c]ertain exemplary embodiments provide.'"

The requirements for an abstract are enumerated in 37 C.F.R. 1.72(b), which states:

[a] brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length.

Suggestions of aspirational desires of the USPTO regarding what an Abstract "should" comprise are not legally binding.

Applicant respectfully submits that the Abstract of the present Application as originally submitted was less than 150 words in length and thus was "brief", pertained to the "technical disclosure", commenced on a separate sheet under the heading "Abstract", and the sheet on which it appeared did not include other parts of the application or other material. Thus, the

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Abstract of the present Application as originally submitted fully complies with the requirements of 37 C.F.R. 1.72(b). For at least these reasons, Applicant respectfully requests a withdrawal of the objection to the Abstract.

**III. Trademark Usage**

The present Office Action indicates that “[a]lthough the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.” Applicant respectfully notes that the present Office Action presents no legal basis for this comment and does not appear to present any objection or rejection regarding the patent application or the claims thereof. Applicant appreciates the recommendation of the present Office Action and believes that the present application as originally submitted respects any trademarked subject matter referenced therein.

**IV. The Statutory Subject Matter Rejections**

Each of claims 1-18 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. As described above, independent claim 1 has been amended, thereby effectively amending those rejected claims that are dependent on claim 1. Reconsideration and withdrawal of these rejections is respectfully requested.

**V. The Obviousness-Type Double Patenting Rejections**

Each of claims 1, 19, and 20 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 33, and 34 of copending U.S. Patent Application No. 10/666,227 (“Poerner”). These rejections are respectfully traversed.

Submitted herewith is a Terminal Disclaimer to Obviate a Double Patenting Rejection.

It is believed that with this Terminal Disclaimer, all claims in this application are in condition for allowance, prompt notice of which is respectfully solicited.

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**VI. The Anticipation Rejections**

Each of claims 1, 8, 10-12, and 19-20 was rejected as anticipated under 35 U.S.C. 102(e). In support of the rejection, various portions of U.S. Patent Application Publication No. 2002/0120921 A1 ("Coburn") were applied. These rejections are respectfully traversed.

**A. The Legal Standards for Express Anticipation Rejections**

To establish a *prima facie* case of express anticipation, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*, MPEP 2131. The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

Coburn fails to establish a *prima facie* case of anticipation.

**B. Analysis**

Specifically, claim 1, from which each of claims 8 and 10-12 depends, and claim 19 state, *inter alia*, yet Coburn does not teach "responsive to a detected collision between a parent node of said hierarchy of said collection and another node, automatically adjusting a position of said parent node". For at least this reason, it is respectfully submitted that the rejection of claims 1

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and 19 is unsupported by Coburn and should be withdrawn. Also, the rejection of 8 and 10-12, each ultimately depending from independent claim 1, is unsupported by Coburn and also should be withdrawn.

Claim 20 states *inter alia*, yet Coburn does not teach “a processor adapted to, responsive to a detected collision between a parent node of said hierarchy of said collection and another node, automatically adjust a position of said parent node”. For at least this reason, it is respectfully submitted that the rejection of claim 20 is unsupported by Coburn and should be withdrawn.

**VII. The Obviousness Rejections**

Each of claims 2-7, 9, and 13-18 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent Application Publication No. 2002/0120921 A1 (“Coburn”) in view of U.S. Patent No. 5,911,145 (“Arora”). Each of these rejections is respectfully traversed.

**A. Legal Standards****1. *Prima Facie* Criteria for an Obviousness Rejection**

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*’s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir.

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1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

## 2. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is “reasonably pertinent to the particular problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

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"References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it" *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*citing In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn* 441 F.3d 977 (Fed. Cir. 2006) (*quoting Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

### 3. Motivation or Suggestion to Combine Prior Art References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *See*, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove "the reasons one of ordinary skill in the art would have been motivated to select the references". *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed" (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

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To show these reasons, “[p]articular findings must be made”. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be “clear and particular”. *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161(Fed. Cir. 1999). That strong showing is needed because, “obviousness requires proof ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; and

“combine [those teachings] in the way that would produce the claimed” subject matter.

*In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). *See also, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing “the test of whether it would have been obvious to select specific teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”). “The absence of . . . a suggestion to combine is dispositive in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious

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modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (*citing In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

**B. Analysis****1. Claims 2-7, 9, and 13-18****a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

**b. Missing Claim Limitations**

Claim 1, from which each of claims 2-7, 9, and 13-18 depend, states, *inter alia*, "responsive to a detected collision between a parent node of said hierarchy of said collection and another node, automatically adjusting a position of said parent node". The applied portions of Coeburn do not teach "responsive to a detected collision between a parent node of said hierarchy of said collection and another node, automatically adjusting a position of said parent node".

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Coeburn.

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

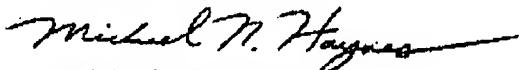
**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 20 October 2006

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